



MAIL STOP PCT
PATENT
9008-1004

IN THE U.S. PATENT AND TRADEMARK OFFICE

In re application of

Paul ROSS et al.

Conf. 8808

Application No. 10/576,010

Group 1632

Filed April 17, 2006

Attn: Erin P. Thomson
Attorney Advisor
PCT Legal Admin.

USE OF PROBIOTIC BACTERIA IN THE TREATMENT OF
INFECTION

RENEWED PETITION UNDER 37 CFR §1.47(a)

Assistant Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

March 20, 2008

Sir:

In response to the Decision on Petition mailed October 22, 2007, applicant hereby renews its petition under Rule 47(a) to accept the present application in the absence of a non-signing inventor.

Applicant hereby reincorporates the allegations made in and the Declaration of Christina Gates attached to the Petition Under 37 CFR § 1.47(a) filed August 6, 2007.

Applicant notes with appreciation the indication in the October 22, 2007 Decision that the first and fourth requirements of Rule 47(a) have been met by the initial petition of August 6, 2007.

The October 22, 2007 Decision (hereafter, "the Decision") contends that the original petition was dismissed on two grounds: (i) that the petition did not adequately demonstrate that the nonsigning inventor was presented with a complete copy of the application papers; and (ii) that the petition lacked a statement of the nonsigning inventor's last known home address.

We address each of the two points raised by the Decision in reverse order.

The Decision states that the third requirement of Rule 47(a) requires a statement of the nonsigning inventor's last known home address. However, we note that Rule 47(a) actually requires "the last known address", without distinguishing between a home or business address. Moreover, MPEP § 409.03(e) states that, "[t]hat address should be the last known address at which the inventor customarily receives mail." (citing MPEP § 605.03). Section 605.03 in turn states that in determining which address an applicant customarily receives mail, "[e]ither applicant's home or business address is acceptable as the mailing address."

Thus, MPEP §§ 409.03(e) and 605.03 taken together state that the third requirement of Rule 47(a) is satisfied by providing the nonsigning inventor's last known home or business address.

Notwithstanding that clear instruction, MPEP § 605.03 includes the apparently contradictory statement that in an application filed under Rule 47, the inventor's most recent home address must be given. However, § 605.03 also explains that the

purpose of providing the nonsigning inventor's address is to "enable the Office to communicate directly with the inventor as necessary," and that that purpose is accomplished by providing each applicant's "mailing address," which mailing address may be "[e]ither applicant's home or business address."

Accordingly, applicant considers that the original petition, which provided the nonsigning inventor's last known business address, fully satisfied the third requirement of Rule 47(a).

In any event, the last known home address of the non-signing inventor, Mr. Stephen Hallahan is:

Cois Abhann, Calbridge,
County Kildare,
Calbridge, IRELAND.

That home address is evidenced by two separate Declarations executed and submitted to the PTO pursuant to 37 CFR § 1.63 by Mr. Hallahan - specifically, in Application Serial Nos. 10/237,788 and 11/607,033. Copies of the foregoing Declarations, which indicate Mr. Hallahan's last known home address, are attached hereto.

As to the second requirement of 37 CFR 1.47(a), the Decision states that the application papers sent to the non-signing inventor "have to reach the inventor to establish refusal."

For the following reasons, applicant respectfully disagrees.

First, neither Rule 47(a) nor the relevant sections of the MPEP impose a requirement that the nonsigning inventor actually receive in-hand the delivered application papers. Rule 47(a) states in pertinent part that it applies "[i]f a joint inventor refuses to join in an application." MPEP § 409.03(d)(II), which identifies possible means of proof of such refusal, states only that the inventor must be "presented with the application papers," which according to that same section of the MPEP is accomplished by sending a copy of the application papers "to the last known address of the nonsigning inventor." Notably, MPEP § 409.03(d)(II) explicitly acknowledges that a *bona fide* attempt to present the application papers, but where the nonsigning inventor refused to accept delivery, may be sufficient.

The original petition includes the Declaration of Dr. Christina Gates, the Managing Partner of Tomkins & Company, European Patent Attorneys, who has firsthand knowledge of the facts surrounding applicant's *bona fide* attempt to present Mr. Hallahan with the application papers and Mr. Hallahan's refusal to execute them. That Declaration includes documentary evidence that the application papers were successfully delivered to the attention of Mr. Hallahan at his known business address. Whether Mr. Hallahan refused delivery from his office or refused to execute and return the application papers is irrelevant to applicant's showing that it made the necessary presentation in compliance with Rule 47(a).

The Decision faults the original petition for allegedly failing to state that applicant verified Mr. Hallahan's business address. To the contrary, the Declaration of Dr. Gates specifically states that a meeting was held with Cross VetPharm Ltd., that Cross VetPharm Ltd.'s employee Mr. Hallahan was identified at that meeting as a co-inventor, and that the application papers were delivered to Mr. Hallahan's attention at his employer Cross VetPharm Ltd.

Applicant submits herewith a second Declaration of Dr. Christina Gates in further support of the fact that applicant verified Mr. Hallahan's business address. Specifically, in the attached second Declaration, Dr. Gates confirms that she received a letter from Cross VetPharm Ltd. stating that Cross VetPharm Ltd. had requested Mr. Hallahan to sign a power of attorney regarding this application. A redacted copy of that letter is attached to Dr. Gates' second Declaration. That copy also indicates that the letter from Cross VetPharm Ltd. was sent July 23, 2007, in response to a letter request from Dr. Gates dated June 15, 2007, both of which therefore occurred at approximately the same time as the application papers were sent to Mr. Hallahan on June 19, 2007 at his Cross VetPharm Ltd. business address. Accordingly, Dr. Gates' second Declaration and the letter attached thereto unequivocally show that Dr. Gates, acting on behalf of applicant, received verification that Mr. Hallahan was at that time employed by Cross VetPharm Ltd.

and in fact received mail correspondence at that business address.

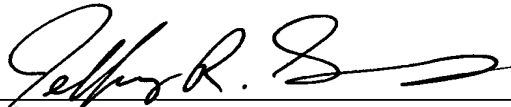
Additionally, Rule 47(a) encompasses a second basis for filing an application despite a nonsigning inventor - specifically, where that inventor "cannot be found or reached after diligent effort."

Thus, even if Mr. Hallahan had not received in-hand the application papers that were successfully delivered to his known business address, that would merely evidence applicant's failure to find or reach the nonsigning inventor after diligent effort.

In view of the above facts, and accompanying supporting documents, it is respectfully requested that the above-identified application be accepted under the provisions of 37 CFR 1.47(a) even though the second listed inventor has refused to execute the application papers.

Respectfully submitted,

YOUNG & THOMPSON



Jeffrey R. Snay, Reg. No. 58,913
209 Madison Street, Suite 500
Alexandria, VA 22314
Telephone (703) 521-2297
Telefax (703) 685-0573
(703) 979-4709



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DECLARATION
AND POWER OF ATTORNEY
U.S.A.FOR ATTORNEY'S USE ONLY
ATTORNEY'S DOCKET NO.ALL PATENTS, INCLUDING DESIGN
FOR APPLICATION BASED ON PCT; PARIS CONVENTION
NON PRIORITY; OR PROVISIONAL APPLICATIONS

As a below named inventor, I declare that my maiden, post office address and citizenship are stated below next to my name, the information given herein is true, that I (inventor) am not an alien, that I am not a citizen of any foreign country (if I am not a citizen of any foreign country, I am not a citizen of any foreign country), and that I am not a resident of any foreign country (if I am not a resident of any foreign country, I am not a resident of any foreign country).

A Bioscience system

101

which is described and claimed in:

☐ PCT International Application No.

and

☒ the attached specification☐ the application in application Serial

and

No

(if applicable) and

amended on

I hereby declare that I have reviewed and understand the contents of the above described specification, including the claims, as amended by any amendments (including by amendment) and I agree to disclose information which is material to patentability as required by the Code of Federal Regulations, 37 CFR.

I hereby claim priority benefits under Title 35, United States Code, 111(a) (3) of any foreign application(s) for claims or invention's patentable subject matter and (where applicable) under the benefit of the priority of the foreign application(s) for claims or invention's patentable subject matter.

Prior Foreign Application(s)

(Number)

(Country)

(Date/Month/Year Filed)

Priority claimed

Yes

No

(Number)

(Country)

(Date/Month/Year Filed)

Yes

No

(Number)

(Country)

(Date/Month/Year Filed)

Yes

No

I hereby claim the benefit under Title 35, United States Code, 111(a) (3) of any foreign application(s) based on:

Application No.

60/317,934

Filing Date

September 10, 2001

Application No.

Filing Date

I hereby claim the benefit under Title 35, United States Code, 111(a) (3) of any foreign application(s) based on the subject matter of any of the claims of the application(s) based on the prior foreign application(s) in the manner provided by the first paragraph of Title 35, United States Code, 111(a) (3), and I acknowledge the duty to disclose information which is material to patentability as required by the Code of Federal Regulations, 37 CFR, which becomes available between the filing date of the present application and the national or PCT international filing date of this application.

105

(No.)

(Application Serial)

(Filing Date)

(Status: pending, pending, abandoned)

POWER OF ATTORNEY: As a named inventor, I hereby appoint the following attorneys (Registration No.) to prosecute this application, receive and act on instructions from my agent and transact all business in the Patent and Trademark Office connected therewith. HARVEY B. JACOBSON JR. (20,851); D. DOUGLAS PRICE (24,514); JOHN CLARKE HOLMAN (22,700); MARVIN R. STERN (20,840); MICHAEL R. SLOBASKY (26,421); JONATHAN L. SCHERER (20,851); IRWIN M. AISENBERG (10,007); WILLIAM E. FLAYER (11,400)

SEND CORRESPONDENCE TO:

JACOBSON, PRICE, HOLMAN & STERN
PROFESSIONAL LIMITED LIABILITY COMPANY
400 SEVENTH STREET N.W.
WASHINGTON, DC, 20004

DIRECT TELEPHONE CALL TO:

(Please use Attorney's Docket No.) (202) 638-1404

JACOBSON, PRICE, HOLMAN & STERN
PROFESSIONAL LIMITED LIABILITY COMPANY

*Inventor(s) names must include at least one pre-specified last or family name.

	FULL NAME OF INVENTOR *	FAMILY NAME	GIVEN NAME	MIDDLE NAME
201	RESIDENCE & CITIZENSHIP	City	STATE OR FOREIGN COUNTRY	COUNTRY OF CITIZENSHIP
	POST OFFICE ADDRESS	POST OFFICE ADDRESS	CITY	STATE OR COUNTRY
				ZIP CODE
202	RESIDENCE & CITIZENSHIP	City	STATE OR FOREIGN COUNTRY	COUNTRY OF CITIZENSHIP
	POST OFFICE ADDRESS	POST OFFICE ADDRESS	CITY	STATE OR COUNTRY
				ZIP CODE

I hereby declare that all of the foregoing information is true and correct to the best of my knowledge and belief, and that I am not an alien, that I am not a citizen of any foreign country (if I am not a citizen of any foreign country, I am not a citizen of any foreign country), and that I am not a resident of any foreign country (if I am not a resident of any foreign country, I am not a resident of any foreign country).

SIGNATURE OF INVENTOR 201

SIGNATURE OF INVENTOR 202

SIGNATURE OF INVENTOR 203

DATE

05.09.02

DATE

5/9/02

DATE

Additional inventors are named on separately numbered sheets attached hereto. (PHS 1985 A-85; 3/86; 5/88) (COPYING WITHOUT LIMITATION)



ALL PATENTS, INCLUDING DESIGN
FOR APPLICATION BASED ON PCT; PARIS CONVENTION;
NON PRIORITY; OR PROVISIONAL APPLICATIONS

DECLARATION
AND POWER OF ATTORNEY
U.S.A.

FOR ATTORNEY'S USE ONLY
ATTORNEY'S DOCKET NO.

As a below named inventor, I declare that the following, both office address and citizenship are stated below next to my name, the information given herein is true, that I possess that I am the original inventor and sole inventor (if only one name is listed at 201 below), or a true and sole inventor in plural inventors are named below at 201-220, or an authorized officer (authorized person) of the business which is claimed to be the inventor (if the inventor is listed).

A Biosecurity system

which is described and claimed by:

☒ the attached specification

PCT International Application No.

(the application in application Serial No.

(if applicable) and

amended on

I hereby state that I have reviewed and understand the contents of the above mentioned specification, including the claims, as amended by any amendments referred to herein. I acknowledge the duty to disclose information which is essential to the prior art as defined in Title 37, Code of Federal Regulations, 1.101. I hereby claim foreign priority benefits under Title 35, United States Code, 119 (a)-(d) of any foreign application(s) for patent or invention's protection based under any laws which contain conditions such as the foreign application(s) defined in the foreign application(s) having a filing date earlier than that of the application on which priority is claimed.

Prior Foreign Application(s)

(Number)

(Country)

(Any/None/Yes/No)

Priority (Claimed)

Yes

No

(Number)

(Country)

(Any/None/Yes/No)

Yes

No

(Number)

(Country)

(Any/None/Yes/No)

Yes

No

I hereby claim the benefit under Title 35, United States Code, 119(a) of any United States provisional application(s) based on:

Application No. 60/317,934

I first filed

September 10, 2001

Application No.

Priority Date

I hereby claim the benefit under Title 35, United States Code, 119(a) of any United States provisional application(s) based on the application in the manner provided by the first paragraph of Title 35, United States Code, 119(a). I acknowledge the duty to disclose information which is essential to the prior art as defined in Title 37, Code of Federal Regulations, 1.101. I acknowledge the duty to disclose information which is essential to the prior art as defined in Title 37, Code of Federal Regulations, 1.101.

No.)

(Application Date)

(Filing Date)

(Date received, pending, abandoned)

POWER OF ATTORNEY: As a named inventor, I hereby appoint the following attorneys (Registration No.) to prosecute this application, receive and act on instructions from my agent, and transact all business in the Patent and Trademark Office connected therewith. HARVEY B. JACOBSON JR. (20,851); D. DOUGLAS PRICE (24,514); JOHN CLARKE HOLMAN (21,711); MARVIN R. STERN (20,840); MICHAEL R. GLOBASKY (26,421); JONATHAN L. SCHERER (28,851); IRWIN M. AISENBERG (19,007); WILLIAM E. FLAYER (31,409)

SEND CORRESPONDENCE TO:

JACOBSON, PRICE, HOLMAN & STERN
PROFESSIONAL LIMITED LIABILITY COMPANY
400 SEVENTH STREET N.W.
WASHINGTON, DC 20004

DIRECT TELEPHONE CALLS TO:

Specify one Attorney's Docket No. (202) (201) (200)

JACOBSON, PRICE, HOLMAN & STERN
PROFESSIONAL LIMITED LIABILITY COMPANY

201	FULL NAME OF INVENTOR	FAMILY NAME	GIVEN NAME	MIDDLE NAME
	RESIDENCE & CITIZENSHIP	CITY	STATE OR FOREIGN COUNTRY	COUNTRY OF CITIZENSHIP
	POST OFFICE ADDRESS	POST OFFICE ADDRESS	CITY	STATE OR COUNTRY
202	FULL NAME OF INVENTOR	FAMILY NAME	GIVEN NAME	MIDDLE NAME
	RESIDENCE & CITIZENSHIP	CITY	STATE OR FOREIGN COUNTRY	COUNTRY OF CITIZENSHIP
	POST OFFICE ADDRESS	POST OFFICE ADDRESS	CITY	STATE OR COUNTRY

Below declare that all of the above made by each inventor are true and that of each inventor on information and have the inventor to do that, and further the above statements are made with the knowledge and belief that the statements are true and that each inventor has executed the statements in the presence of the inventor.

SIGNATURE OF INVENTOR 201: *[Signature]* DATE: 05.09.02

SIGNATURE OF INVENTOR 202: *[Signature]* DATE: 05/02

Additional inventors are named on separately numbered sheets attached hereto. JPMAY 1985 A/R; 3/06; 5/98 (COPYING WITHOUT LIMITATION NOTED)

BEST AVAILABLE COPY



Declaration

I, Christina Gates, Managing Partner of Tomkins & Company, European Patent Attorneys, make this declaration.

I am the Patent Attorney responsible for preparing and drafting Irish Patent Application No.2003/0773 entitled " Use of Probiotic Bacteria in the Treatment of Infection". This is the priority application on which U.S. Patent Application Serial No. 10/576,010, which is the national stage of PCT/IE2004/000143.

The invention arises out of collaborative research conducted between Teagasc, the Agricultural & Food Development authority, University College Cork, and a company, Cross VetPharm Limited. At a meeting between representatives of these parties, inventorship of the invention was determined, and a verbal agreement made for assignment of rights between the various parties.

Further to my declaration of 27th July 2007, please find attached to this declaration a redacted copy of a letter received from Stephen Hallahan's employer, Cross VetPharm Group Limited indicating that Mr Hallahan's employer had asked him to sign the Power of Attorney form. I understand this letter to mean that the inventor's business address is current and that although the application papers were received and signed for by someone other than the inventor, the papers have been given to the inventor for signature and he has been directed to sign them by his employer.

I still have not received the signed documentation from Stephen Hallahan. I therefore assumed that Mr Hallahan has refused to join in the application papers.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that wilful false statements and the like so made are punishable by fine or imprisonment, or both under Section 1001 of Title 18 of the United States Code and that such wilful false statements may jeopardise validity of the application or any patent issued thereon.

Signed:


Christina Gates Ph.D
Managing Partner
Tomkins & Co.

Dated:

7th March 2008



Private & Confidential

**Fax Transmission: 660 69 20
& Postal Service**

**Ms. Christina Gates
Managing Partner
Tomkins & Co
Patent and Trade Mark Attorneys
5 Dartmouth Road
Dublin 6**



**CROSS VETPHARM
GROUP LIMITED**

23rd July 2007

**Re: United States of America Patent Application No 10/576,010 – Teagasc –
National Dairy Products Research Centre and University College, Cork –
National University of Ireland**

Dear Christina,

I refer to your letter of 15th June 2007 in relation to the above matter.

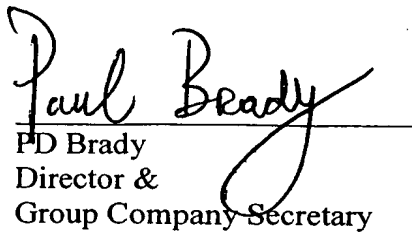
In view of the presumed deadline in the United States of America, I have requested Steve Hallahan to sign a modified version of the United States of America Power of Attorney Form. I understand that this will allow the United States of America patent application to proceed.

The issue of an assignment is not, I understand, critical at this stage.

If you should have any questions, please do not hesitate to contact me.

Yours sincerely,

For and on behalf of Cross Vetpharm Group Limited


PD Brady
Director &
Group Company Secretary

23 / July / 2007

Fax transmission: 025 422 22
& Postal Service

Copy: Dr. Paul Ross
National Dairy Products Research Centre
Teagasc – Irish Agriculture and Food Development Authority
Moorepark
Fermoy
Co. Cork